

## REMARKS

This Response is submitted in reply to the Final Office Action dated February 4, 2009. Claims 1, 4, 10, 18, 29, 37, 48, 56 to 58, 62, 66, and 67 are amended. Claims 5, 13, 22, 32, 41, and 52 stand canceled. No new matter has been added by these amendments. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response.

The Office Action rejected Claims 1 to 4, 6 to 12, 14 to 21, 23 to 31, 33 to 40, 42 to 51, and 53 to 67 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0036419 to Baerlocher et al. ("Baerlocher"). Applicant disagrees with and traverses this rejection for at least the following reasons.

The Abstract of Baerlocher discloses that:

[t]he present invention provides a processor controlled gaming device that randomly generates a plurality of positions or digits of an award and enables the player to pick which position or digit receives a first randomly generated number, which digit receives a second randomly generated number, etc., until each of the positions have a number, whereby the gaming device determines the player's ultimate award. The present invention further provides a plurality of modification methods for modifying the digits of the award.

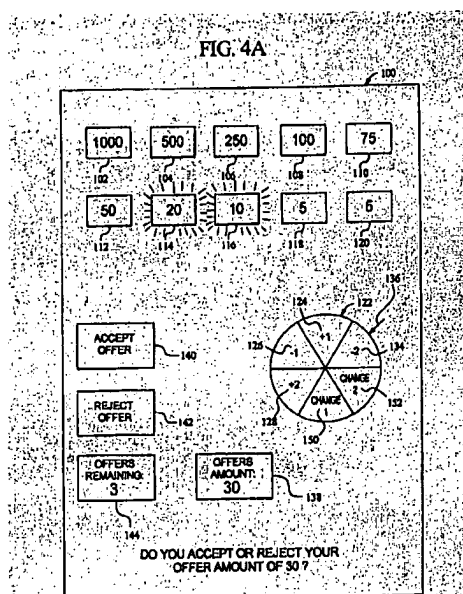
Amended independent Claim 1 is directed to a gaming device including, amongst other elements, a plurality of awards, wherein each of the awards has an award value greater than zero, a plurality of the award values have a same number of digits, and each of the awards is statically associated with one of the offer components for a play of a game and a mechanical wheel including a plurality of sections, wherein each section is associated with one of a plurality of different displayed component number modifiers, and each component number modifier has a displayed value. The gaming device of amended independent Claim 1 also includes a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to select at least one offer component to activate from the plurality of displayed offer components, thereafter, display at least one of the award values of at least one of the awards associated with at least one of the activated offer components, determine and display an offer based on a summation of the award values of all of the awards associated with

the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits.

Baerlocher does not anticipate or render obvious a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to determine and display an offer based on a summation of the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits.

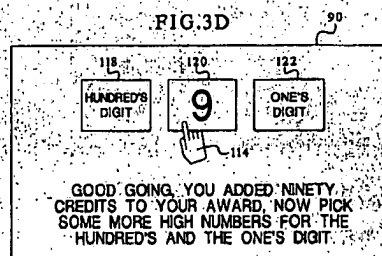
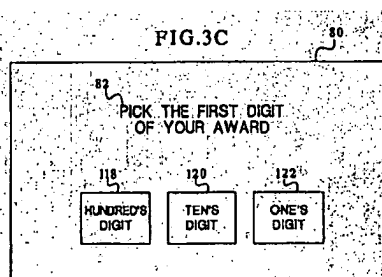
Pages 29 and 30 of the previous Response to Office Action explained that:

[i]t appears that the Office Action is interpreting the "selected award values" as the "number in the positions" of Baerlocher. Applicant submits that under this interpretation no two interpreted "award values" of Baerlocher have the same number of digits. For example, Fig. 9 of Baerlocher illustrates an award of 614. Applicant submits that this award appears to include a 6 in the hundreds position (i.e., 600 has 3 digits), a 1 in the tens position (i.e., 10 has 2 digits), and a 4 in the ones position (i.e., 4 has 1 digit), resulting in an award of 614. In this example, 600, 10, and 4 are the "selected award values", and the award of 614 is "based on all of the selected award values" (i.e.,  $600+10+4=614$ ). On the other hand, the gaming device of amended independent Claim 1 is directed to, amongst other elements, a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to determine and display an offer based on the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits. For example, as seen in Fig. 4A of the present application (reproduced below), the gaming system determines and displays an offer amount of 30 in offer amount display 138. In this example, the determined offer includes activated offer components 114 and 116, which display award values of 20 and 10 respectively, and the award values of 20 and 10 each have the same number of digits (i.e., the award value 20 has 2 digits, and the award value 10 has 2 digits).



In response to these remarks, Page 2 of the present Office Action stated that:

[a] player determines an offer based on the award value that are determined from the activation order of the offer components (fig. 3D, 120) and all possible awards consist of the same number of digits. (emphasis added)



Thus, it appears that the Office Action is interpreting the possible 3-digit number combinations of Baerlocher as the plurality of awards having a same number of digits of independent Claim 1. Under this interpretation, it appears that Baerlocher determines only one of the possible 3-digit numbers to be an offer. Under this interpretation, because only one 3-digit number is determined to be the offer, Baerlocher does not anticipate or render obvious determining an offer based on a summation of awards. Rather, under the Office Action's interpretation, an offer in Baerlocher is based on only a single 3-digit number (and thus not on a summation of a plurality of award values greater than zero). On the other hand, amended independent Claim 1 is directed to a gaming device including, amongst other elements, a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to determine and display an offer based on a summation of the award values of all of the awards associated with the activated offer components. It would not have been obvious to one of ordinary skill in the art to modify Baerlocher to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

Moreover, Page 3 of the Office Action stated:

[a]dditionally the displaying of all possible modifiers at once to a player is also viewed as mere design choice since in both games the player has no say in which modifier will be used therefore each game takes a different approach on 'building suspense' as unknown (prior art) or identified (applicant) consequences.

Applicant disagrees and reiterates the arguments conveyed in the Responses to the Office Actions of June 3, 2008 and October 23, 2008, that each component number modifier has a displayed value is substantially more than a simple design choice and that it is improper for the Office Action to contend that prior art references do not disclose certain claimed elements and then simply state that these claimed elements are a simple design variation. Without providing any reference which discloses these claimed elements, any conclusions that such claimed elements are a simple design choice is impermissible. As stated in *In re Chu*, the finding of *In re Gal* is that "obvious design choice" is precluded where the claimed structure and the function it performs are

different from the prior art. *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995); *In re Gal*, 980 F.2d 717 (Fed. Cir. 1992)..

Applicant also reiterates the argument conveyed in the Responses to the Office Actions of June 3, 2008 and October 23, 2008, that Baerlocher does not anticipate or render obvious a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value. That is, the possible award modifications of *Baerlocher* are not displayed to the player when the player decides whether to keep the currently generated award or risk the award to generate one of the award modification methods.

For at least these reasons, amended independent Claim 1 is patentably distinguished over Baerlocher and is in condition for allowance.

Claims 2 to 4 and 6 to 9 depend directly or indirectly from amended Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 each include certain similar elements to amended independent Claim 1. For reasons similar to those discussed above with respect to amended independent Claim 1, amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 (and dependent Claims 11, 12, 14 to 17, 19 to 21 23 to 28, 30, 31, 33 to 36, 38 to 40 42 to 47, 49 to 51 53 to 55, 59 to 61, and 63 to 65) are each patentably distinguished over Baerlocher and are in condition for allowance.

Applicant submits that on June 3, 2008, Applicant's representative and the Examiner had an interview. On June 16, 2008, the Examiner issued an Interview Summary which stated:

[t]he applicant and the Examiner both agree that the prior art teaches the game play methodology.

In a Response to Final Office Action dated June 25, 2008, Applicant stated:

[a]pplicant respectfully disagrees and submits that no agreement was reached regarding the game play methodology of the prior art in relation to the claims of the present application.

In a July 30, 2008 Office Action, the Response to Arguments Section on Page 5 stated:

[o]ne final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaching the gameplay methodology of the applicant's limitations when asking the Examiner to identify any allowable subject matter. Therefore it is possible for the applicant to disagree with this statement since these current arguments are made by Mr. Masia.

Following receipt of this July 30, 2008 Office Action, Applicant's representative contacted the Examiner to disagree that the prior art teaches the game play methodology.

On August 13, 2008, the Examiner issued a Supplemental Interview Summary which stated:

[t]he Examiner returned Mr. Masia's phone call to clarify a section of the last Action's Response to Arguments: 'One final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaches [teaching] the gameplay methodology of the applicant's limitation when asking the Examiner to identify any allowable subject matter.' For the record, the Examiner's use of the term gameplay methodology refers to the game's overall idea or theme: a player is allowed to accept or reject an award offer knowing a rejection will result in a with mathematical alteration of the offer.

Accordingly, Applicant submits that this issue had been resolved.

However, Page 5 of the preset Office Action stated:

[o]ne final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaching the gameplay methodology of the applicant's limitations when asking the Examiner to identify any allowable subject matter. Therefore it is possible for the applicant to disagree with this statement since these current arguments are made by Mr. Masia.

As seen above, this exact passage was also included in the previous Office Action dated July 30, 2008. Again, Applicant respectfully disagrees and submits that no agreement was reached regarding the game play methodology of the prior art in relation to the claims of the present application.

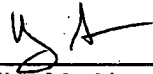
An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions

regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

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Dated: April 3, 2009